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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,237	10/30/2003	Thomas F. Willey	TMLIN.001A	3359

20995 7590 12/15/2006

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EXAMINER

Cain, Edward J

ART UNIT	PAPER NUMBER
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1714

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,237

Applicant(s)

WILLEY ET AL.

Examiner

Edward J. Cain

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 September 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-35,38 and 40-73 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,31,38 and 58-73 is/are allowed.
- 6) ☒ Claim(s) 2,4-30,32,33,35,40,42-46,50,52-55 and 57 is/are rejected.
- 7) ☒ Claim(s) 34,41,47-49,51 and 56 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

The amendment received 9/29/06 has been made of record. Claims 1, 2, 4-35, 38 and 40-73 are pending.

The rejections under 35 USC 102 and 103 contained in the previous office action are withdrawn in view of applicants' amendments.

Upon further consideration the indicated allowability of claims 2, 6-9, 29, 31 and 38 is withdrawn.

Claims 2, 4 and 5 are rejected under 35 U.S.C. 102(b) as being anticipated by Wu.

Wu discloses polyalphaolefins suitable for grease formulations. The PAO is seen as meeting the limitations of the rejected claims.

Claims 6-9, 24-28, 42-46 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slack in view of Wu, Koltermann et al and Lawate et al.

Slack discloses grease compositions comprising POA, alkyl naphthalenes and paraffin oil. These compositions are further taught as comprising complex soaps and amine or phenolic antioxidants. The reference fails to explicitly disclose properties for the PAO such as claimed instantly, the use of benzotriazole as metal deactivator and the use of molybdenum disulfide as extreme pressure agent.

Wu discloses grease compositions comprising PAO meeting applicants limitations and benefits to be derived from the use of these particular PAO's.

Lawate et al teach the benefits of benzotriazole as metal deactivator in similar lubricant compositions.

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Koltermann teaches the art known use of molybdenum disulfide as extreme pressure agent in similar PAO based grease compositions.

Claims 10-23, 29-30, 32, 33, 35, 40, 52-55 and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koltermann et al in view of Wu

Koltermann et al teach grease compositions comprising PAO, ester base, complex soaps, non-soap thickeners, ptfе, molybdenum disulfide and antioxidants. The reference fails to explicitly teach PAO with applicants' claimed properties.

Wu discloses grease compositions comprising PAO meeting applicants limitations and benefits to be derived from the use of these particular PAO's.

Molybdenum disulfide is seen as inherently functioning as an antisieze agent.

Claims 34, 41, 47-49, 51 and 56 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 1, 31, 38 and 58-73 are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edward J. Cain whose telephone number is (571) 272-1118. The examiner can normally be reached on M-F from 10:00 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan, can be reached on 571 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Edward J. Cain
Primary Examiner
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A handwritten signature in black ink, appearing to read 'E. J. Cain', is written over the printed name and title.